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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,647	02/21/2002	Takashi Nozaki	B-4511 619552-8	1969

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EXAMINER

TAYLOR, NICHOLAS R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/081,647	NOZAKI ET AL.	
	Examiner	Art Unit	
	Nicholas R Taylor	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/07/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 have been examined and are rejected.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 8 recites the limitation "said telephone function." There is insufficient antecedent basis for this limitation in the claim.

For the purpose of this office action, "said telephone function" is interpreted to mean the telephone function by which a call operation is initiated to a link indicated by a telephone number, as stated in claim 3.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-7, 9-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita et al. (US Patent 6,622,174) and Murata et al. (US PGPub 2001/0005854.)

7. As per claim 1, Ukita teaches an electronic mail processing system that processes email messages sent via a network, said system comprising:

a plurality of terminals each provided with a function to send and receive the email messages through said network; (Ukita, column 4, lines 50-61)

a user information storage device for storing user information corresponding to registered users; (Ukita, column 9, lines 59-66)

an email adding device for referencing said user information storage device upon receipt of each of the email messages sent from said terminals, acquiring at least one predetermined item of information, and adding information to the email message; and (Ukita, column 11, lines 5-14)

an email forwarding device for forwarding the email message to which said predetermined item of said user information is added, to said terminals specified as recipients (Ukita, column 10, lines 18-28.)

However, Ukita fails to teach wherein said information acquired for and added to the email message contains user information. Murata teaches an email adding device that references user information, specifically positional information, and adds this

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information to an email message (Murata, paragraph 0052-0054.) It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita and Murata to provide the user information adding of Murata in the system of Ukita, because doing so would improve the convenience and effectiveness of positional data added to email (Murata, paragraph 0009.)

8. As per claim 2, Ukita-Murata teaches the system further wherein said user information includes telephone number data, and wherein said email adding device adds the telephone number data to the email message (Murata, paragraph 0052, wherein the positional data includes telephone number data.)

9. As per claim 4, Ukita-Murata teaches the system further wherein said user information includes position information, and wherein said email adding device adds the position information to the email message (Murata, paragraph 0052.)

10. As per claim 5, Ukita-Murata teaches the system further wherein said user information includes position information and map link information corresponding to the position information, and wherein said email adding device adds the map link information to the email message (Murata, paragraph 0052 and 0062.)

11. As per claim 6, Ukita-Murata teaches the system further wherein said plurality of terminals include terminals having an Internet access function and a display device, and

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wherein when said email forwarding device forwards the email message to which the map link information is added, the Internet access function allows map information to be acquired from an Internet site indicated by the map link information based on a predetermined operation, to display an image corresponding to the map information on said display device (Murata, paragraph 0062.)

12. As per claim 7, Ukita-Murata teaches the system further wherein said plurality of terminals include portable terminals each provided with a function to send and receive the email messages by radiocommunication via base stations (Ukita, column 5, lines 47-54.)

13. As per claim 9, Ukita teaches a mail server for processing email messages sent via a network to which a plurality of terminals are connected, said mail server comprising:

a user information storage device for storing user information corresponding to registered users; (Ukita, column 9, lines 59-66)

an email adding device for referencing said user information storage device upon receipt of each of the email messages sent from said terminals, acquiring at least one predetermined item of information, and adding said item of said information to the email message; and (Ukita, column 11, lines 5-14)

an email forwarding device for forwarding the email message to which said predetermined item of said user information is added, to said terminals specified as recipients (Ukita, column 10, lines 18-28.)

However, Ukita fails to teach wherein said information acquired for and added to the email message contains user information corresponding to users using said terminals. Murata teaches an email adding device that references user information, specifically positional information, and adds this information to an email message (Murata, paragraph 0052-0054.) It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita and Murata to provide the user information adding of Murata in the system of Ukita, because doing so would improve the convenience and effectiveness of positional data added to email (Murata, paragraph 0009.)

14. As per claim 10, Ukita-Murata teaches the system further wherein said user information includes telephone number data, and wherein said email adding device adds the telephone number data to the email message (Murata, paragraph 0052, wherein the positional data includes telephone number data.)

15. As per claim 11, Ukita-Murata teaches the system further wherein said user information includes position information, and wherein said email adding device adds the position information to the email message (Murata, paragraph 0052.)

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16. As per claim 12, Ukita-Murata teaches the system further wherein said user information includes position information and map link information corresponding to the position information, and wherein said email adding device adds the map link information to the email message (Murata, paragraph 0052 and 0062.)

17. As per claims 13 and 15-17, Ukita-Murata teaches the system further wherein said plurality of terminals include portable terminals each provided with a function to send and receive the email messages by radiocommunication via base stations (Ukita, column 5, lines 47-54.)

18. Claims 3, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita et al. (US Patent 6,622,174) and Murata et al. (US PGPub 2001/0005854), further in view of Kamada et al. (US Patent 6,192,258.)

19. As per claim 3, Ukita-Murata teaches the above, yet fails to teach wherein said plurality of terminals include terminals having a telephone function by which a call operation is initiated to a link indicated by the telephone number data based on a predetermined operation.

Kamada teaches a function operable on a user terminal wherein a user can initiate a call operation through a link to telephone number data (Kamada, column 10, lines 42-47.) It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita-Murata and Kamada to provide the

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telephone call link of Kamada in the system of Ukita-Murata, because doing so would enhance the operability of the user terminal (Kamada, column 2, lines 37-39.)

20. As per claim 8, Ukita-Murata teaches the above, yet fails to teach wherein said portable terminals include portable terminals provided with said telephone function.

Kamada teaches a function operable on a portable user terminal wherein a user can initiate a call operation through a link to telephone number data (Kamada, column 10, lines 42-47.) It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Ukita-Murata and Kamada to provide the telephone call link of Kamada in the system of Ukita-Murata, because doing so would enhance the operability of the user terminal (Kamada, column 2, lines 37-39.)

21. As per claim 14, Ukita-Murata-Kamada teaches the system further wherein said plurality of terminals include portable terminals each provided with a function to send and receive the email messages by radiocommunication via base stations (Ukita, column 5, lines 47-54.)

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes US Patents 6,076,101 and 6,202,086, and US PGPub 2001/0005861.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor
Examiner
Art Unit 2141


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER